

REMARKS

Reconsideration is requested.

Claims 1, 2 and 21-37 are pending. The details of claim 38 have been added to independent claim 36, from which claim 38 depended. Independent claims 21 and 28 have been revised to specify that the recited treatment process produces the recited beneficial and unexpected property of the claimed product, i.e., shifting absorbance peak of porous semiconductor layer on which a dye sensitizer is adsorbed. The claimed product is therefore materially different from a similar product not produced by the recited process of the claimed product. The manufacturing process steps of the claims impart distinctive structural characteristics to the final product of the claims. See MPEP § 2113. Claim 28 has been amended, without prejudice, to include the compounds of, for example, pages 14-15 of the disclosure. No new matter has been added.

The Section 102 rejections of claims 21-25, 28-32 and 35 over Lupo (U.S. Patent No. 5,885,368) is traversed. Reconsideration and withdrawal of the rejection are requested in view of the following distinguishing comments.

The Examiner is understood to rely on a recitation of “dried briefly in a warm air stream” in Example 10 of Lupo to allegedly inherently provide the products of the rejected claims.

The reference to “warm air” in Lupo however, without more, fails to demonstrate that the claimed invention would necessarily flow from the teaching of the patent. As

explained by the Board in Ex parte Levy, 17 USPQ2d 1461, 1463-1464 (Bd. Pat. App. & Int. 1990),

“the initial burden of establishing a prima facie basis to deny patentability to a claimed invention rests upon the examiner. In re Piasecki, 745 F.2d 1468, 223 USPQ 785 (Fed.Cir. 1984). In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. In re King, 801 F.2d 1324, 231 USPQ 136 (Fed.Cir. 1986); W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed.Cir. 1983); In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); In re Wilding, 535 F.2d 631, 190 USPQ 59 (CCPA 1976); Hansgirk v. Kemmer, 102 F.2d 212, 40 USPQ 665 (CCPA 1939).”

The present disclosure teaches a heating temperature of 100 to 180°C, for example, to produce a product having a shift in the absorbance peak. See page 13 of the present application.

The cited art would not be expected by one of ordinary skill to inherently produce the unexpected and beneficial property of the disclosure and claims.

Moreover, the rejected independent claim 21, and claims 22-25 dependent therefrom, require light radiation to produce the shift in absorbance, which is not literally or inherently taught by the cited art. Further, the rejected independent claim 28, and claims 29-32 and 35 dependent therefrom, require a chemical treatment to produce the shift in absorbance, which is not literally or inherently taught by the cited art. The Examiner's comments regarding claims 28 and 35 on pages 3-5 of the Office Action of June 16, 2008 and the reference to MPEP § 2113, are noted. The Examiner is

requested to see however the above with regard to MPEP § 2113 and the amended claims.

Claim 21-25, 28-32 and 35 are patentable over Lupo. Withdrawal of the Section 102 rejection of claims 21-25, 28-32 and 35 over Lupo is requested.

The Section 102 rejection of claims and 21-25, 28-32 and 35-37 Yoshikawa (PGPub 20020040728) is traversed. Reconsideration and withdrawal of the rejection are requested in view of the following distinguishing comments.

As with Lupo, the applicants believe the cited reference fails to literally or inherently teach the claimed invention.

Withdrawal of the Section 102 rejection is requested.

The Section 103 rejection of claims 1, 2, 26, 27, 33, 34 and 36-38 over Lupo and Andriessen (WO2004/025748) is traversed. Reconsideration and withdrawal of the rejection are requested as Andriessen is not believed to cure the deficiencies of Lupo noted above. Moreover, the cited combination of art would not have led one of ordinary skill in the art to predict the unexpectedly beneficial results achieved with the claimed invention, as demonstrated by the present disclosure. Even if one of ordinary skill would have used a dye sensitizer of the secondary reference in place of a dye sensitizer of the primary reference, as alleged by the Examiner, the ordinarily skilled person would not have expected the beneficial results achieved by the claimed product.

The claims are submitted to be patentable over the cited combination of art. Withdrawal of the Section 103 rejection is requested.

The Section 103 rejection of claims 1 and 2 over Yoshikawa and Andriessen (WO2004/025748) is traversed. Reconsideration and withdrawal of the rejection are requested as Andriessen is not believed to cure the deficiencies of Yoshikawa noted above. Moreover, the cited combination of art would not have led one of ordinary skill in the art to predict the unexpectedly beneficial results achieved with the claimed invention, as demonstrated by the present disclosure. Even if one of ordinary skill would have used a dye sensitizer of the secondary reference in place of a dye sensitizer of the primary reference, as alleged by the Examiner, the ordinarily skilled person would not have expected the beneficial results achieved by the claimed product.

The claims are submitted to be patentable over the cited combination of art. Withdrawal of the Section 103 rejection is requested.

The Section 103 rejection of claims 26, 27, 33, 34 and 38 over Yoshikawa is traversed. Reconsideration and withdrawal of the rejection are requested as Yoshikawa is not believed to suggest the invention of the rejected claims. The cited art would not have led one of ordinary skill in the art to predict the unexpectedly beneficial results achieved with the claimed invention, as demonstrated by the present disclosure. Withdrawal of the Section 103 rejection is requested.

The claims are submitted to be in condition for allowance and a Notice to that effect is requested. The Examiner is requested to contact the undersigned, preferably by telephone, in the event anything further is required to place the present application in condition for allowance.

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Respectfully submitted,

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